

REMARKS/ARGUMENTS

The Office Action mailed October 20, 2006 has been carefully considered.
Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendment to the Claims

Claims 39-82 are now pending. No claims stand allowed.

Claims 39, 46-50, 54-55, 58-63, 65-70, and 72-82 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification, page 5, lines 4-17, page 9, lines 22-26, page 10, line 20 through page 11, line 9, page 18, lines 9-15, page 24, lines 14-20 and FIG. 8. The amendment also contains minor changes of a clerical nature.

No “new matter” has been added by the amendment.

The 35 U.S.C. §112 Rejection, Second Paragraph

Claims 39-54, 58-73, 77, 78, 80, and 81 stand rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. This rejection is respectfully traversed.

a. Regarding Claims 39, 43, 46, 50, 58, 62, 65, 69, 77, 78, 80, and 81:

In the Office Action, the Examiner alleges that “if...” clauses recited in those claims are “[c]onditional language inherently comprises at least two conditions: the ‘if’ and the ‘if not’”, and that lacking limitations “regarding how [the] system is to perform if the ‘if not’ conditions holds,” “one of ordinary skill is hindered from determining the scope and how to use said system.” The Applicants respectfully disagree for the following reasons.

The MPEP provides as follows:

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.¹

¹ MPEP § 2173.

Breadth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.²

First, there is no provision in the MPEP or patent law providing that “if” clause (allegedly a conditional language) is *per se* indefinite under 35 U.S.C. §112, or requiring to recite “if not” condition whenever “if” condition is recited. Thus, the Examiner’s allegation requiring “if” and “if not” conditions does not have legal basis.

The claims as amended recite, for example, “if a previous session using said client software completed unsuccessfully: offering a user an option...” In this case, if in a certain method or apparatus a previous session using client software never completes unsuccessfully, such a method or apparatus would not infringe the present claim because the claim language does not read on such a method or apparatus. If in a certain method or apparatus a previous session using client software completes unsuccessfully, but the certain method or apparatus does not offer a user an option, as recited, such a method or apparatus would not infringe the claim, either, because the claim language still does not read on such method or apparatus. Accordingly, without reciting an “if not” condition in the claims, the scope of the present claims is clear so that the public is informed of the boundaries of what constitutes infringement of the patent, meeting the 35 U.S.C. §112 requirements.

Furthermore, the alleged “if not” condition would simply be another limitation narrowing the scope of the claims. For example, if the claim further recites an “if-not” condition such as “if a previous session using client software did not complete unsuccessfully, performing A,” any method or apparatus which does not perform A if a previous session using client software did not complete unsuccessfully still would not infringe the claims even if the method or apparatus otherwise fully satisfy the “if” condition. Thus, lacking the alleged “if not” condition is the breadth of the claim which should not to be equated with indefiniteness.

² MPEP § 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971) (emphasis added).

In addition, it is respectfully submitted that the alleged requirement of determining “how to user said system” is not a requirement for the claims, but the description in the specification as to the claimed invention. The MPEP provides for the enablement requirements as follows:

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention.³

Furthermore, with respect claim 50, 62, and 69, the condition “if the client has proper network configuration and registry setting to accomplish communication with the electronic network” is not predicated on the client receiving “an approval signal” as the Examiner alleges. The client is only required to have “proper network configuration and registry setting to accomplish communication,” not to actually conduct two-way communications, as those of ordinary skill in the art would understand from the claims.

Accordingly, withdrawal of the 35 U.S.C. §112, second paragraph, rejection is respectfully requested.

b. Regarding claim 44:

In the Office Action, the Examiner alleges that claim 44 recites “sending ... confirming that the client system is still connected.” However, claim 44 was amended in Applicant’s previous response filed August 15, 2006 to recite “sending ... to determine a connection status of the client system,” and thus this rejection is moot.

Accordingly, withdrawal of the 35 U.S.C. §112, second paragraph, rejection is respectfully requested.

c. Regarding claims 58, 65, 74, and 77-82:

Claims 58, 65, and 74 (and their dependent claims) have been amended to more clearly recite the configuration of the claimed servers.

³ MPEP § 2164 (emphasis added).

The MPEP provides as follows:⁴

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

It should be noted that claims 58, 65, and 74 (and their dependent claims) do not claim “both an apparatus and a method” as the Examiner alleges, but the apparatus (server) and its configuration “to define a particular capability that is served by the recited element.”

Claims 77-79 recite a program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform a method for... , and thus do not recite “both an apparatus and a method” as the Examiner alleges. It should be noted that such a “program of instructions” is a “functional descriptive material,” and “[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”⁵

Claims 80-82 are apparatus claims including functional limitations which are typically referred to as “means plus function” claims. 35 U.S.C. §112, the sixth paragraph allows such claims as follows:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, ...

⁴ MPEP, §2173.05(g).

Accordingly, withdrawal of the 35 U.S.C. §112, second paragraph, rejection is respectfully requested.

The 35 U.S.C. §103 Rejection

Claims 39-57 and 65-82 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Budow et al. (U.S. Pat. No. 5,661,517) in view of Lewis (U.S. Pat. No. 5,612,730), among which claims 39, 46, 55, 65, 74, and 77-82 are independent claims.

Claims 58-64 also stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Budow et al. (U.S. Pat. No. 5,661,517) in view of Ahmad (U.S. Pat. No. 5,565,908) and Lewis (U.S. Pat. No. 5,612,730), among which claim 58 is the independent claim.

These rejections are respectfully traversed.

According to M.P.E.P. §2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Claim 39 defines a method for providing communication among a client system, a server system and an electronic communications network, the client system including a Central Processor Unit (CPU), volatile working memory associated with the CPU, and a communications interface, the client system further running client software for managing the communications between the client system and the electronic communications network, the server system running

⁵ MPEP §2106.01.

server software for managing communications between a plurality of client systems and the electronic communications network. The claimed method comprises (a) if a previous session using said client software completed unsuccessfully: (i) offering a user an option of either continuing or restoring system settings of said client system; (ii) receiving from said user an indication responsive to said offering; and (iii) determining whether to restore said system settings based at least in part on said indication, (b) specifying a billing preference, said billing preference chosen from a predefined set of billing options, said billing options including at least one technique for making a monetary payment, (c) transmitting said billing preference to the server system, (d) receiving a billing approve/reject signal from the server system, (e) accessing the electronic communications network via the server system if an approve signal is provided in said receiving, and (f) conducting two-way communications with the electronic communications network via the server system, as recited in claim 39 as amended.

In the Office Action, the Examiner specifically contends that elements (b), (c), and (d) of the presently claimed invention are disclosed in Budow except that Budow does not teach element (f) (and also element (e) as amended). The Examiner further contends that Lewis teaches elements (f) and that it would be obvious to one having ordinary skill in the art at the time of the invention “to combine the teachings of Budow and Lewis in order to generate additional revenue streams for providing access to the internet.”

However, claim 39 (and other independent claims 46, 55, 58, 65, 74, and 77-82) was amended by the previous response to recite, (a) if a previous session using said client software completed unsuccessfully, (i) offering a user an option of either continuing or restoring system settings of said client system, (ii) receiving from said the user an indication responsive to the offering, and (iii) determining whether to restore the system settings based at least in part on the indication. These limitations are not taught or suggested by Budow, Lewis or other prior art of record (as discussed in the Applicants' previous response). Claims 46, 55, 58, 65, 74, and 77-82 also recite substantially the same distinctive features as claim 39, as presented by the previous amendment. Nevertheless, the Examiner fails to raise any rejections based on prior art or otherwise mention or address with respect to the previously presented limitations in the Office Action.

Accordingly, the Applicant respectfully submits the rejection of Claims 39-57 and 65-82 under 35 U.S.C. § 103 is unsupported by the art and must be withdrawn.

Dependent Claims 43-45, 47, 50-52, 56-57, 66, 69-71, and 75-76

As to dependent Claims 43-45, 47, 50-52, 56-57, 66, 69-71, and 75-76, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Second 35 U.S.C. § 103 Rejection

Claims 58-64 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Budow et al. in view of Ahmad⁶, among which Claim 58 is an independent claim. This rejection is respectfully traversed.

By the previous amendment, independent claim 58 was modified to recite, (a) if a previous session using said client software completed unsuccessfully, (i) offering a user an option of either continuing or restoring system settings of said client system, (ii) receiving from said the user an indication responsive to the offering, and (iii) determining whether to restore the system settings based at least in part on the indication. This is not taught or suggested by the prior art of record, and the Examiner fails to present, in the Office Action, any rejections or discussions based on prior art as to these limitations as discussed above.

Accordingly, the Applicant respectfully submits the rejection of Claim 58 under 35 U.S.C. § 103 is unsupported by the art and must be withdrawn.

Dependent Claims 59-64

As to dependent Claims 59-64, the argument set forth above is equally applicable here. The base claim being allowable, the dependent claims must also be allowable.

⁶ U.S. Patent No. 5,565,908.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-1698.

Respectfully submitted,
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